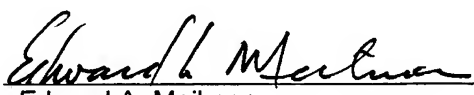




Handwritten initials and a checkmark in the top right corner.

TRANSMITTAL OF APPEAL BRIEF			Docket No. E4355.0002
In re Application of: Ivailo E. Stanimirov et al.			
Application No. 10/031,592-Conf. #6275	Filing Date January 23, 2002	Examiner M. L. Ferguson	Group Art Unit 2854
Invention: POLYCHROMATIC PRINTED CORKS AND METHOD FOR MAKING THE SAME			
<p style="text-align: center;"><u>TO THE COMMISSIONER OF PATENTS:</u></p> <p>Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>May 24, 2006</u></p> <p>The fee for filing this Appeal Brief is <u>\$ 500.00</u></p> <p><input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity</p> <p><input type="checkbox"/> A petition for extension of time is also enclosed. The fee for the extension of time is _____</p> <p><input type="checkbox"/> A check in the amount of _____ is enclosed.</p> <p><input type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>50-2215</u> This sheet is submitted in duplicate.</p> <p><input checked="" type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-2215</u> This sheet is submitted in duplicate.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end;"><div> Edward A. Meilman Attorney Reg. No. : 24,735 DICKSTEIN SHAPIRO LLP 1177 Avenue of the Americas 41st Floor New York, New York 10036-2714 (212) 896-5471</div><div>Dated: <u>July 24, 2006</u></div></div>			

BEST AVAILABLE COPY



Docket No.: E4355.0002
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Ivailo E. Stanimirov et al.

Application No.: 10/031,592

Confirmation No.: 6275

Filed: January 23, 2002

Art Unit: 2854

For: POLYCHROMATIC PRINTED CORKS
AND METHOD FOR MAKING THE SAME

Examiner: M. L. Ferguson

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on May 24, 2006, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

07/25/2006 JADD01 00000010 10031592

01 FC:1402

500.00 0P

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings
- Appendix A Claims
- Appendix B Evidence

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

CORTEC OOD

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 9 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 1, 9
2. Claims withdrawn from consideration but not canceled: 0
3. Claims pending: 2-8, 10-11
4. Claims allowed: 2-8
5. Claims rejected: 10-11

C. Claims On Appeal

The claims on appeal are claims 10-11.

IV. STATUS OF AMENDMENTS

Applicants did not amend the application after Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Natural cork has a pliable and non calibrated surface. When used to close an opening in a wine bottle, it is in cylindrical form. These characteristics make the application of decorations to the cork surface by any method difficult. Those

difficulties are magnified should it be attempted to apply a multicolored image to the cylindrical cork surface.

The Applicants discovered how to overcome the inherent difficulties of applying a multicolored image to a cylindrical natural cork surface. Their printing process is novel and unobvious, and claims to the process have been allowed. The product achieved, a polychromatically decorated non-calibrated cylindrical natural cork is the subject of this appeal.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) over Sayre (US 5,654,022) in view of Lauer (US 6,616,997) -- Final rejection mailed February 24, 2006.

VII. ARGUMENT

This application should have been allowed in full a very long time ago. In the first merits Action, the process claims were allowed and the product claim rejected. The Examiner then offered to allow the case if the product claim was cancelled. Applicants declined but the Examiner "misunderstood" and cancelled the claim. Rather than correct the misunderstanding, the Examiner forced Applicants to Petition to achieve reinstatement of the product claim. Applicants added a product-by-process claim (claim 10) which the Examiner allowed twice. To expedite allowance, Applicants then cancelled the traditional product claim but the Examiner responded by withdrawing the allowance of the product-by-product claim. Accordingly, Applicants then restored the cancelled product claim (as claim 11) to the application. They also

a communication explaining why the references did not render the invention obvious, that the invention met a long felt need and also illustrated the product. A particularly frustrating aspect of the application process is that the Examiner waited until issuing the current Final Rejection (the 5th Office Action in this case) to assert a novel interpretation of the rejected claims and then refused to allow Applicants to revise the claims to eliminate any possibility that the claims could be misinterpreted as the Examiner had done. The correct meaning of the claims is discussed below.

There are two product claims on appeal. Claim 11 calls for a cork having a printed image on its non-calibrated cylindrical surface, in which the image is polychromatic. Appealed Claim 10 recites the product as that of the method of allowed claim 2. This product, whether defined in conventional product language or in product-by-process language, is neither taught nor suggested by the combination of references on which the Examiner has relied. Indeed, the rejection on appeal is predicated on a misreading of the claims.

The Examiner's Rejection Is Not Based On The Pending Claims

The claims on appeal are concerned with natural cork which has been polychromatically printed. Since the Examiner has located no prior art which is relevant to that product, the claims have been reinterpreted to give the term "cork" a very different meaning. To justify the new construction of the term, the Examiner has cited a definition of cork found on the internet on the grounds that the PTO is entitled to give claims their broadest reasonable interpretation.

The Examiner's approach to claim construction is in error because it fails to recognize is that expression "broadest reasonable interpretation" is just a shorthand for the rule that the PTO should give claims their broadest reasonable construction "in

light of the specification as it would be interpreted by one of ordinary skill in the art.”

Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ 2d 1321, 1329 (Fed. Cir.

2005)(Emphasis Added). “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification” and its prosecution history. *Id.* 415 F.3d at 1313, 75 USPQ2d at 1326.

When the requirement that the construction be made “in light of the specification as it would be interpreted by one of ordinary skill in the art” is observed, the Examiner’s position, first advanced in the fifth Office Action, on the meaning of the term “cork” is both unreasonable and untenable.

The fact that the cork is natural cork is implicit and fully supported by the application as originally filed and moreover, the definition of “cork” was a topic of discussion during prosecution for quite some time.

Thus, the application as originally filed refers cylindrical items made of cork on pages 1, 2, 3 and 8. Figure 1 of the application is a picture of a number of corks with polychromatic images on them, i.e., what is being claimed. The four corks shown in that picture are made of natural cork. The specification shows that “cork” means natural cork.

In an Amendment in August 2003, references were distinguished on the grounds that they related to materials made of synthetic materials rather than cork. Similarly, in an Amendment filed in January 2005, the Lauer reference was distinguished on the grounds it related to synthetic materials rather than cork and the in Amendment filed in December 2005 that reference was once again distinguished on the grounds it dealt with a synthetic material rather than natural cork. The prosecution history also shows that “cork” means natural cork.

In the Final Rejection, the fifth Office Action in this case, it was stated for the first time that the claims did not explicitly disclose of what material the cork is made, whether natural cork or a plastic, and an internet dictionary cited in support of a very expansive definition that the term “cork” meant any type of stopper. That action ignored the admonitions of the Federal Circuit:

The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent. Properly viewed, the “ordinary meaning” of a claim term is its meaning to the ordinary artisan after reading the entire patent. Yet heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.

...Dictionaries, by their nature, provide an expansive array of definitions. General dictionaries, in particular, strive to collect all uses of particular words, from the common to the obscure. By design, general dictionaries collect the definitions of a term as used not only in a particular art field, but in many different settings. In such circumstances, it is inevitable that the multiple dictionary definitions for a term will extend beyond the “construction of the patent [that] is confirmed by the avowed understanding of the patentee, expressed by him, or on his behalf, when his application for the original patent was pending.” ... Moreover, different dictionaries may contain somewhat different sets of definitions for the same words. A claim should not rise or fall based upon the preferences of a particular dictionary editor, or the court’s independent decision, uninformed by the specification, to rely on one dictionary rather than another.

Phillips v. AWH Corp., 415 F.3d at 1321-22, 75 USPQ 2d at 1332-33.

The record here illustrates the validity of part of the Court’s warning -- Applicants made of record a page from the Merriam-Webster’s Collegiate Dictionary,

10th Edition (2001) setting forth a definition of cork which excludes the concept on which the Final Rejection sought to rely¹.

The Examiner's attempt to construe "cork" as meaning any stopper regardless of material of construction is unreasonable. When the term is given broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, as is required, it means natural cork.

The Appealed Claims, Properly Construed, Are Patentable

The primary reference, Sayre, does not teach or suggest the existence of a colored image on a cylindrical cork. Instead, it relates to a heat shrink capsule for closing flange bottle tops whose openings may, for example, be closed by a cork. The Examiner averred that the reference teaches a cork surface with decorations, designs, logos or the like on the surface although it failed to "explicitly disclose printing with a polychromatic image on the surface" but this is inaccurate and a vast overstatement of the disclosure in the reference. Nothing in that disclosure discloses, explicitly or implicitly, the existence of a colored decoration, be it monochromatic or polychromatic, nor is there any disclosure, explicit or implicit, of how any decoration was achieved. There is thus no teaching or suggestion in Sayre of either color or printing. The decorations, etc., may have been paced on the cork surface by burning a design into the surface or even by adhering a printed image on paper to the surface with an adhesive. The Sayre reference is thus deficient in at least two aspects, namely it does not teach or suggest placing anything on the cork surface by printing and secondly, it does not teach or suggest a colored image on the surface, much less a polychromatic image, regardless of how such an image would be applied.

¹ Applicants offered by telephone to amend the claims in order to make it even more clear that the cork of

The Lauer reference does not overcome either of the deficiencies in Sayre. At best, it discloses printing indicia on a non-cork surface. The reference is concerned with a synthetic closure made of plastic, possibly encased in an envelope also made of plastic, which is used as substitute for cork in order to avoid various difficulties encountered with natural cork. All references to cork in Lauer are limited to being a description of cork's limitations or saying the plastic substitute can exhibit the appearance of or the desirable sealing properties of cork. When it is indicated that indicia can be formed on the synthetic material by, *inter alia*, conventional printing techniques, it must be appreciated that this is a reference to printing on plastic. The statement would also be understood by those of ordinary skill in the art as referring to an additional advantage exhibited by the synthetic plastic material which is not exhibited by cork. There is nothing in this reference which teaches or suggests that conventional printing techniques may be used to provide natural cork with indicia and beyond this deficiency, there is nothing which teaches or suggest that a colored image, much less a polychromatic image, may be achieved by printing on the cork.

Hence, one of the references on which the appealed rejection relies says, at best, there can be something on the surface of a cork. The other reference says you can print something on a plastic substitute for cork. Any combination of these references results in substituting plastic for cork and then printing on the plastic, but that is not the claimed invention. The alleged justifications for combining the references, namely, that it is obvious to combine these references to realize a colored design on cork or a "visual appealing appearance of the cork", is not based on any disclosure in the references but rather is an after-the-fact expansive revision of their teachings using both hindsight and the present invention as a template. This is also apparent from the

the claims is natural cork. Because the Examiner advised that the proposed change constituted a new issue and would not be entered, such an amendment was not proffered.

selection, for no stated reason, of conventional printing rather than embossing or etching (Lauer, col. 7, 41-43). Indeed, it is not even obvious-to-try (which is insufficient under § 103 in any event) printing on a natural cork surface in light of Lauer in that there is nothing which would motivate one skilled in the art to even attempt a conventional printing process with cork. The surface of the synthetic plastic material in Lauer is relatively hard and non-pliable while the surface of cork is relatively soft and pliable, thereby presenting very different problems to one who might seek to apply something to these surfaces.

Nothing in Sayre or Lauer, whether considered alone or in combination, teaches or suggests that a natural cork having a polychromic image on its non-calibrated cylindrical surface can be achieved.

The Examiner's Final Rejection is untenable and should be reversed.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

A copy of the allowed claims is also in Appendix A.

IX. EVIDENCE

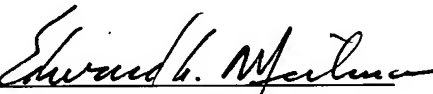
A copy of evidence pursuant to §§ 1.130, 1.131, or 1.132 and/or evidence entered by or relied upon by the examiner or Applicants that is relevant to this appeal is attached hereto as Appendix B.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Related Proceedings Appendix is included.

Dated: July 24, 2006

Respectfully submitted,

By 

Edward A. Meilman

Registration No.: 24,735
DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 277-6500
Attorney for Applicant

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/031,592:

10. Cork with printed image on its non-calibrated cylindrical surface, characterized by that the image is polychromatic and produced by the method of claim 2.

11. A cylindrical cork with printed image on its non-calibrated cylindrical surface, characterized by the image being polychromatic.

Claims Allowed in Application Serial No. 10/031,592:

2. Method for printing of polychromatic images on cork, wherein colours separation has previously been made, that by using i basic colours, where $i = 2$ to n allows the formation of polychromatic image, the corks are delivered to an operating zone, and the corresponding inks according to the number of the basic colours are conducted to printing rollers by means of transfer rollers, by oscillation, inks are spread over the cylindrical surface of the cartridges for the achievement and the maintenance of a regular ink layer characterized by, that corks (1) are successively supplied one after the other vertically in the operating zone by gravitation at which the cork (1) that will be printed is fixed with its axis in vertical position with the possibility of unlimited rotation around the axis of its cylindrical surface, establishing simultaneous contact with radially placed fixing devices (7_i) where $j = 3$ to m along the effective diameter of the cork (1), by which all fixing devices (7_i) come into contact in their corresponding contact points thus eliminating the deviations in the cylindrical shape of the surrounding surface of the cork (1), then all printing rollers (6_i) with

diameter equal to the diameter of the cork (1) enter into simultaneous contact with the cylindrical surface at the level of the effective diameter of the cork (1), following a simultaneously rotation of the cork (1) at one revolution by the fixing devices (7_i), that make the turn along with the printing rollers (6_i) at equal peripheral speed in their contact points with the cork (1) surface, while all printing rollers (6_i) spread simultaneously the print of the corresponding colour (2_i) on the colour zone of the cork (1) surface corresponding to each roller (6_i), according to the previous colour separation, and at the end of the turn, the polychromatic image (3) on the surface of the cork (1) is fully made, and then all printing rollers (6_i) and fixing devices (7_i) are drawn back from the cork (1), its axis is released and is pulled back from the operating zone, at which in the interval to the next loading of the operating zone, the printing rollers (6_i) make contact with the transporting rollers (5_i) to cover their printing relief with the corresponding ink colour, and during the printed interval, when the printing rollers (6_i) are not in contact with the transporting rollers (5_i), the latter make contact with intermediate rollers (8_i) that are in constant contact with the supply surface of the corresponding ink cartridges (4_i) for each colour and transfer ink to the corresponding intermediate rollers (8_i) during the whole rotation of each ink cartridge (4_i), and all the time while the rotation of each ink cartridge (4_i) is taking place, the thickness and regularity of the ink layer on its transferring surface is additionally maintained within the normal range by oscillating spread, being the axis of at least one printing roller (6) during the printing process fixed strongly in radial position to the cork (1), and the axes of the remaining printing rollers (6) exercise a selective radial pliability to the cork (1) surface.

3. Method for printing polychromatic images on cork (1) according to claim 2, characterized by that the axes of all printing rollers (6) exercise a selective radial pliability with regards to the cork (1) surface.

4. Polychromatic image printing machine on cork (1) consisting of printing roller, ink cartridge, fixed to the base of the machine, transferring, and intermediate roller, characterized by that there are $n - 1$ more printing rollers (6_i), ink cartridges (4_i), transferring rollers (5_i) and intermediate rollers (8_i), wherein n is the number of colours (2) of the colour separation, and over the operating zone there is a vertical floating magazine (9), and under the operating zone there is an orifice (10) to a chute (11), and a mobile vertical support (12) with vacuum catch (13) of its upper edge is aligned to the axis of the operating zone and passes through the orifice (10), and in upper end position contacts the cork (1) with the vacuum catch (13), and in the lower end position is under the level of the orifice (10), at which the fixing rollers (7_j) where $j = 3$ to m are placed vertically with rotation axis parallel to the axis of the operating zone, that in printing mode, the printing rollers (6_i) and the fixing rollers (7_j) are positioned to the effective diameter of the cylindrical surface of the cork (1), the axis of at least one printing roller (6) is fixed firmly in radial position to the cork (1), and the axes of the other printing rollers (6) have a selective radial pliability to the cork (1) surface, and the printing rollers (6_i) are not in contact with the transporting rollers (5_i), the latter being in contact with the intermediate rollers (8_i), that are in permanent contact with the spreading surface of the corresponding ink cartridges (4_i) for each colour (2), that in recharging mode, all printing rollers (6_i) and fixing rollers (7_j) are set aside the cork (1), the printing rollers (6_i) are in contact with their corresponding transporting rollers (5_i), and the latter are not in contact with the intermediate rollers (8_i), that every ink cartridge (4_i) has an oscillating roller (14) with axis parallel to the axis of the ink cartridge (4), and outer surface being in permanent contact with the spreading ink cartridge (4) surface, that the axis of this oscillating roller (14) is connected to the axis of the worm (15) of a worm redactor (16), its worm-wheel (17) being connected through an eccentrically fixed lever (18) to a support (19) of the oscillating roller (14), that the axis of every fixing roller (7) is articulated through a slide

(20), which is placed into a channel (21) formed by support sectors (22), and a leading roller (23), fixed to the lower part of the slide (2), is placed into a guiding channel (24) in rotating leading synchronized disk (25) which rotation axis fits in the axis of the operating zone, and a chain wheel (26) fixed to the synchronizing disk (25) by first leading chain (27) is connected to the engine axis (28) providing radial movement of the pressing rollers (7) to and from the effective diameter of the cork (1), that the axis of every pressing roller (7) under the slide (20) is articulated in the inner edge of an arm (29), which outer end is articulated to arm (30), freely articulated on a central axis (31), articulated in the carcass of the machine, wherein the central axis (31) is articulated along a second axis (32) in which lower end are located two gear-wheels (33) and (34), and in their upper end is located a gear-wheel (35), that through a second chain (36) is connected to a gear-wheel (37), fixed to the axis (38) of the printing head (6), that an engine for rotation of one cycle (39) by third chain (40) is connected to the gear wheels (33) of all second axis (32), which lower gear-wheels (34) through their corresponding fourth chains (41) are connected to lower gear-wheels (42) on axes (43), positioned along the axis in the axes (44) of the articulations between the arms (29) and (30), upper gear wheels (45) of the axes (43) are connected to fifth chains (46) to their corresponding gear-wheels (47) in the lower end of the axes of the fixing rollers (7), that at least one central axis (31) is connected to the corresponding leading fork (48) in which channel (49) is located pin (50), eccentrically positioned to the axis of the engine (51) for putting it in motion, that to every central axis (31) is fixed a curved arm support (52) for the corresponding printing roller (6), articulated in its curved edge, the arms (52) being kinematically connected and synchronized thorough their corresponding gear-wheels (53), fixed to the central axes (31) and covered by a sixth chain (54), that a supporting fork (55) is freely articulated under every arm support (52) towards its central axis (31), an eccentric stop (56) being installed to the fork, being the arm (57) of the stop articulated to the arm support (52), and a leading pneumatic cylinder (58) is articulated

between the fork (55) and the arm (52), at which fork (59) for the intermediate roller (8) and the support (19), made as a fork (60), for the oscillating roller (14) are articulated to the fork (55), and the rollers (8) and (14) placed over them are constantly pressed to the cylindrical surface of the ink cartridge (4) by means of a spring (61) between fork (59) and fork (60).

5. Polychromatic image printing machine on cork according to claim 4, characterized by that all central axes (31) covered by the sixth chain (54) are connected through it directly to the axis of the oscillating engine (51).

6. Polychromatic image printing machine on cork according to claim 4, characterized by that all gear belt washers (62) of the ink cartridges (4) are grasped by a gear belt (63), connected through a support roller (64) with a gear belt wheel (65) to the engine axis (66) for setting them in motion.

7. Polychromatic image printing machine on cork according to claim 4, characterized by that the supplying magazine (9) consist of various guides (67), forming a vertical channel (68), and every guide (67) has at any edge one adjustable support (69), and at least one of these guides is mobile and is provided of a guiding element (70), its internal surface having projection (71) for contact with the cork (1) that is on the exit of the vertical channel (68).

8. Polychromatic image printing machine on cork according to claim 4, characterized by that every adjustable support (69) consists of slide (72) for connecting to the corresponding guide (67), pressed by a spring (73) into a cylinder (74) and supporting with its head an adjusting screw (75).

APPENDIX B

Merriam-Webster's Collegiate Dictionary, 10th Edition (2001) page 257

●UPDATED ANNUALLY●

Merriam- Webster's **Collegiate** **Dictionary**

TENTH EDITION

THE WORDS YOU NEED TODAY

- Clear and precise
- Best guidance on word choice
- Most definitions—over 215,000

AN ENCYCLOPÆDIA BRITANNICA® COMPANY

BEST AVAILABLE COPY

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☒ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☒ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.